

device. The first device has IP telephony capability and ATM capability. IP telephony media for the session is transported between the called party and a second device. The second device also has IP telephony capability and ATM capability. An ATM virtual circuit is established for the session between the first device and the second device. The data path for the telephony session is secured by the use of proxy addressing. The step of securing the data path by proxy addressing is described in great detail on pages 5 – 7, and also shown in detail in Figure 2.

Claim 20 is directed to a system for providing a quality of service IP telephony session between a calling party and a called party. The system includes an IP telephony network. The IP telephony network provides IP telephony access to the calling party and to the called party. The system also includes an ATM network. A first device is connected between said IP telephony network and said ATM network. The first device provides bi-directional translation between IP media traffic and ATM traffic. A second device is connected between said IP telephony network and said ATM network. The second device provides bi-directional translation between IP media traffic and ATM traffic. An intelligent control layer establishes a virtual circuit through said ATM network for an IP telephony session between the calling party and the called party, whereby the first device and the second device are assigned on a per session basis.

Roy is directed to a wide area network that includes the interconnection of customer premise LANs via an ATM wide area network. Routers are disposed between the IP networks and the ATM network. The routers are configured to encapsulate the IP packets to transfer the data over the ATM network. The configuration of Roy is very similar to the arrangement described in the background section of the present invention. The problem associated with Roy, and with the approach discussed in the background of the invention, is that (1) possible destination IP addresses need to be provisioned in the router ahead of time, and, (2) it is not possible to define which IP flow should get the ATM service and which should get the IP best efforts service. In other words, when a destination address is provisioned in the router, then all traffic to that destination address will be carried by the ATM virtual circuit.

According to **MPEP 2131**, "to anticipate a claim, the reference must teach every element of the claim." A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

With respect to claims 1, 2, 3, and 20-23, Roy does not expressly or inherently describe each and every element as set forth in the claims. For example, while Roy describes the interconnection of customer premise LANs via an ATM wide area network, Roy does not disclose the step of securing a data path for the telephony session by the use of proxy addressing, as recited in claim 1. Further, Roy does not disclose an intelligent control layer that establishes a virtual circuit through said ATM network by assigning the first device and the second device on a per session basis, as recited in claim 20.

For the above reasons, the applicant respectfully asserts that claims 1-4 and 20-24 are patentable under 35 U.S.C. § 102(e).

B. The Examiner has rejected claims 5-19 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,366,578 to Johnson. The Applicant respectfully traverses the rejection because the Examiner has failed to make a prima facie case of anticipation because the cited reference does not inherently or expressly describe each element set forth in the claims.

Claim 5 is directed to a method for providing quality of service in an IP telephony session between a calling party and a called party. The method includes the steps of assigning a temporary IP proxy address to the called party at a first access control manager. A temporary IP proxy address is assigned to the calling party at a second access control manager. A switched virtual circuit is established for the session between the first access control manager and the second access control manager.

Claim 12 is directed to a method for providing quality of service in an IP telephony session between a calling party and a called party. The method includes the steps of assigning a temporary IP proxy address to the called party at a first access control manager. A temporary IP proxy address is assigned to the calling party at a second access control manager. A temporary second network calling party address is assigned for said session at said first access control manager. Finally, a temporary second network calling party address is assigned for said session at said second access control manager.

Johnson is directed to a small office communications system, a full PBX type telecommunications system 50 that supports both voice and data communications. See col. 1, line 57- col. 2, line 63, and col. 2, line 66 – col. 3, line 60. The heart of the PBX system 50 is host processor 70. See col. 7, lines 16-20, col. 8, lines 16-26 and col. 8, lines 55-58. As shown in Figure 2, communications system 50 is coupled to the telephone network via digital

trunks 54 and POTS (plain old telephone service) trunks 54. Internally, system 50 is coupled to file server 20, printer 22, work station terminals 24, telephone sets 12, and Fax machine 44. The file server employs Dynamic Host Configuration Protocol (DHCP) to assign IP addresses to workstation computers 24. The applicant does not agree with the Examiner's characterization of the Johnson reference.

As stated above, to anticipate a claim, the reference must teach every element of the claim. Johnson is not on point because it is directed to PBX office equipment, whereas the present invention is directed to IP network telephony. Johnson does not teach every element of the claim. In particular, Figure 3 of Johnson does not include an ATM network, as the Examiner suggests. For example reference numeral 82, which includes a box labeled "ATM," refers to an interface card. See col. 10, lines 21-37. Reference 79b and 79c, which are also labeled "ATM," also refer to plug-in cards. See col. 10, lines 46-56. Contrary to the Examiner's assertions, Johnson does not disclose a method for providing quality of service between a called party and a calling party because Johnson is not directed to networking callers over a network. Instead, Johnson discloses a single PBX system. Johnson also does not teach or suggest access control managers that are configured to assign temporary IP proxy addresses as recited in claim 5 and claim 12. Johnson also does not disclose the establishment of a switched virtual circuit for an IP telephony session between two access control managers as recited in claim 5. Johnson also does not assign temporary calling party addresses for each session, as recited in claim 12.

For the above reasons, the applicant respectfully asserts that claims 5-19 are patentable under 35 U.S.C. § 102(e).

2. § 103 Rejections

The Examiner has rejected dependent claims 3 and 24 under 35 U.S.C. § 103 as being unpatentable for obviousness over Roy in view of Johnson. The applicant respectfully traverses this rejection because the prior art references do not teach or suggest all the claim limitations, and also because there is no motivation to combine Roy and Johnson.

According to the **MPEP 2143**, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when

combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claim 3 depends from claim 1. Claim 24 depends from claim 20. As discussed above, Roy does not disclose all of the claim elements of claim 1 or claim 20. Thus, Roy cannot have all of the limitations of claim 3 and claim 24. Further, claim 3 and claim 24 are allowable in their own right because Roy does not teach or suggest the step of identifying parties using temporary session IP proxy addresses, as recited by claim 3 and claim 24.

There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine Roy and Johnson. Roy is directed to providing multi-media conferencing over a hybrid WAN, whereas Johnson is directed to a PBX that is designed, in part, to accommodate analog POTS trunks. As stated in MPEP 2143.01, it is not obvious to combine references when the combination changes the principle of operation of one of the references.

For the above reasons, the applicant respectfully asserts that claims 3 and 24 are patentable under 35 U.S.C. § 103(a).

3. Conclusion

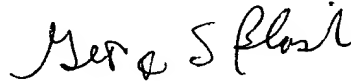
Based upon the above remarks and papers of record, Applicant believes the pending claims of the above-captioned application are in allowable form and patentable over the prior art of record. Applicant respectfully requests reconsideration of the pending claims 1-24 and a prompt Notice of Allowance thereon.

Applicant believes that no extension of time is necessary to make this Response timely. Should Applicant be in error, Applicant respectfully requests that the Office grant such time extension pursuant to 37 C. § 1.136(a) as necessary to make this Response timely, and hereby authorizes the Office to charge any necessary fee or surcharge with respect to said time extension to the deposit account of the undersigned firm of attorneys, Deposit Account 13-2491.

Please direct any questions or comments to Daniel P. Malley at (607) 256-7307.

Respectfully submitted,

WALL MARJMA & BILINSKI LLP



Date: September 30, 2002

George S. Blasiak
Registration No. 37,283
WALL MARJMA & BILINSKI LLP
101 S. Salina Street
Suite 400
Syracuse, NY 13202